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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/810,395	03/19/2001	Michael A. Muller	366.125	6004
5514	7590	06/28/2004	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO			YOUNG, JOHN L	
30 ROCKEFELLER PLAZA			ART UNIT	
NEW YORK, NY 10112			PAPER NUMBER	

3622

DATE MAILED: 06/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/810,395

Applicant(s)

MULLER, MICHAEL A.

Examiner

John L Young

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 March 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-103 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-103 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

JOHN LEONARD YOUNG, ESQ.
PRIMARY EXAMINER

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>5</u> . | 6) <input type="checkbox"/> Other: _____ |

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NON-FINAL ACTION

DRAWINGS

1. This application has been filed with drawings that are considered informal; said drawings are acceptable for examination purposes. The review process for drawings that are included with applications on filing has been modified in view of the new requirement to publish applications at eighteen months after the filing date of applications, or any priority date claimed under 35 U.S.C. §§119, 120, 121, or 365.

CLAIM REJECTIONS — 35 U.S.C. §101

35 U.S.C. §101 reads as follows:

Whoever invents or discovers any new and useful
process, machine, manufacture, or composition of matter or
any new and useful improvement thereof, may obtain a
patent therefore, subject to the conditions and requirements
of this title.

2. Claims 65-82 are rejected under 35 U.S.C. 101, because said claim is directed to non-statutory subject matter.

As per claim 65, as drafted said claim is not limited by language within the

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technological arts (see *In re Waldbaum*, 173 USPQ 430 (CCPA 1972); *In re Musgrave*, 167 USPQ 280 (CCPA 1970) and *In re Johnston*, 183 USPQ 172 (CCPA 1974) also see MPEP 2106 IV 2(b), even though said claim is limited by language to a useful, concrete and tangible application (See *State Street v. Signature financial Group*, 149 F.3d at 1374-75 , 47 USPQ 2d at 1602 (Fed Cir. 1998); *AT&T Corp. v. Excel*, 50 USPQ 2d 1447, 1452 (Fed. Cir. 1999).

Note: it is well settled in the law that “[although] a claim should be interpreted in light of the specification disclosure, it is generally considered improper to read limitations contained in the specification into the claims. See *In re Prater*, 415, F.2d 1393, 162 USPQ 541 (CCPA 1969) and *In re Winkhaus*, 527 F.2d 637, 188 USPQ 129 (CCPA 1975), which discuss the premise that one cannot rely on the specification to impart limitations to the claims that are not recited in the claims.” (See MPEP 2173.05(q)).

Dependent claims 66-82 are rejected pursuant to 35 U.S.C. 101 for substantially the same reasons as independent claim 65.

CLAIM REJECTIONS — 35 U.S.C. §103(a)

The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-103 are rejected under 35 U.S.C. §103(a) as being unpatentable over Gardner 6,064,978 (05/16/2004) [US f/d: 06/24/1997] (herein referred to as ("Gardner").

As per claim 1, Gardner (the ABSTRACT; FIGs. 1-7; col. 5-67; col. 2, ll. 1-67; col. 3, ll. 1-67; col. 4, ll. 1-67; col. 5, ll. 1-40; and whole document) shows: "a network . . . [and receiving] from a first participant via the network a formulation of a problem to be solved; [receiving] from a plurality of other participants via the network suggested solutions to the problem; and [distributing] portions of an award to those participants who contribute suggested solutions to the problem."

Gardner lacks an explicit recitation of a "server on a network". It would have been obvious to a person of ordinary skill in the art at the time of the invention that the

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disclosure of Gardner cited above would have been selected in accordance with a “server on a network” because selection of such features would have provided means “*to answer questions for payment, using a pay-for-answers system such as that of www.answers.com.*” (See Gardner (col. 2, ll. 15-20)).

As per claims 2-22, Gardner shows the system of claim 1 and subsequent base claims depending from claim 1.

Gardner (the ABSTRACT; FIGs. 1-7; col. 5-67; col. 2, ll. 1-67; col. 3, ll. 1-67; col. 4, ll. 1-67; col. 5, ll. 1-40; and whole document) shows the elements and limitations of claims 2-22.

Gardner lacks explicit recitation of the elements and limitations of claims 2-22.

“Official Notice” is taken that both the concept and the advantages of the elements and limitations of claims 2-22 were well known and expected in the art by one of ordinary skill at the time of the invention. It would have been obvious to include the selection of such elements and limitations as found in claims 2-22, because selection of such features would have provided means “*to answer questions for payment, using a pay-for-answers system such as that of www.answers.com.*” (See Gardner (col. 2, ll. 15-20)).

Independent claim 23 is rejected for substantially the same reasons as independent claim 1.

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As per claims 24-32, Gardner shows the system of claim 23 and subsequent base claims depending from claim 23.

Gardner (the ABSTRACT; FIGs. 1-7; col. 5-67; col. 2, ll. 1-67; col. 3, ll. 1-67; col. 4, ll. 1-67; col. 5, ll. 1-40; and whole document) shows the elements and limitations of claims 24-32.

Gardner lacks explicit recitation of the elements and limitations of claims 24-32.

"Official Notice" is taken that both the concept and the advantages of the elements and limitations of claims 24-32 were well known and expected in the art by one of ordinary skill at the time of the invention. It would have been obvious to include the selection of such elements and limitations as found in claims 24-32, because selection of such features would have provided means *"to answer questions for payment, using a pay-for-answers system such as that of www.answers.com."* (See Gardner (col. 2, ll. 15-20)).

Independent claim 33 is rejected for substantially the same reasons as independent claim 1.

As per claims 34-54, Gardner shows the system of claim 33 and subsequent base claims depending from claim 33.

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Gardner (the ABSTRACT; FIGs. 1-7; col. 5-67; col. 2, ll. 1-67; col. 3, ll. 1-67; col. 4, ll. 1-67; col. 5, ll. 1-40; and whole document) shows the elements and limitations of claims 34-54.

Gardner lacks explicit recitation of the elements and limitations of claims 34-54.

"Official Notice" is taken that both the concept and the advantages of the elements and limitations of claims 34-54 were well known and expected in the art by one of ordinary skill at the time of the invention. It would have been obvious to include the selection of such elements and limitations as found in claims 34-54, because selection of such features would have provided means *"to answer questions for payment, using a pay-for-answers system such as that of www.answers.com."* (See Gardner (col. 2, ll. 15-20)).

Independent claim 55 is rejected for substantially the same reasons as independent claim 1.

As per claims 56-64, Gardner shows the system of claim 55 and subsequent base claims depending from claim 55.

Gardner (the ABSTRACT; FIGs. 1-7; col. 5-67; col. 2, ll. 1-67; col. 3, ll. 1-67; col. 4, ll. 1-67; col. 5, ll. 1-40; and whole document) shows the elements and limitations of claims 56-64.

Gardner lacks explicit recitation of the elements and limitations of claims 56-64.

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"Official Notice" is taken that both the concept and the advantages of the elements and limitations of claims 56-64 were well known and expected in the art by one of ordinary skill at the time of the invention. It would have been obvious to include the selection of such elements and limitations as found in claims 56-64, because selection of such features would have provided means *"to answer questions for payment, using a pay-for-answers system such as that of www.answers.com."* (See Gardner (col. 2, ll. 15-20)).

Independent claim 65 is rejected for substantially the same reasons as independent claim 1.

As per claims 66-82, Gardner shows the method of claim 65 and subsequent base claims depending from claim 65.

Gardner (the ABSTRACT; FIGs. 1-7; col. 5-67; col. 2, ll. 1-67; col. 3, ll. 1-67; col. 4, ll. 1-67; col. 5, ll. 1-40; and whole document) shows the elements and limitations of claims 66-82.

Gardner lacks explicit recitation of the elements and limitations of claims 66-82.

"Official Notice" is taken that both the concept and the advantages of the elements and limitations of claims 66-82 were well known and expected in the art by one of ordinary skill at the time of the invention. It would have been obvious to include the selection of such elements and limitations as found in claims 66-82, because selection of

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such features would have provided means *"to answer questions for payment, using a pay-for-answers system such as that of www.answers.com."* (See Gardner (col. 2, ll. 15-20)).

Independent claim 83 is rejected for substantially the same reasons as independent claim 1.

As per claims 84-103, Gardner shows the code of claim 83 and subsequent base claims depending from claim 83.

Gardner (the ABSTRACT; FIGs. 1-7; col. 5-67; col. 2, ll. 1-67; col. 3, ll. 1-67; col. 4, ll. 1-67; col. 5, ll. 1-40; and whole document) shows the elements and limitations of claims 84-103.

Gardner lacks explicit recitation of the elements and limitations of claims 84-103.

"Official Notice" is taken that both the concept and the advantages of the elements and limitations of claims 84-103 were well known and expected in the art by one of ordinary skill at the time of the invention. It would have been obvious to include the selection of such elements and limitations as found in claims 84-103, because selection of such features would have provided means *"to answer questions for payment, using a pay-for-answers system such as that of www.answers.com."* (See Gardner (col. 2, ll. 15-20)).

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CONCLUSION

4. Any response to this action should be mailed to:

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Any response to this action may be sent via facsimile to either:

(703)305-7687 (for formal communications EXPEDITED PROCEDURE) or

(703) 305-7687 (for formal communications marked AFTER-FINAL) or

(703) 746-7240 (for informal communications marked PROPOSED or DRAFT).

Hand delivered responses may be brought to:

Seventh Floor Receptionist
Crystal Park V
2451 Crystal Drive
Arlington, Virginia.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John L. Young who may be reached via telephone at (703) 305-3801. The examiner can normally be reached Monday through Friday between 8:30 A.M. and 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, may be reached at (703) 305-8469.

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(Muller)

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

John L. Young

Primary Patent Examiner



JOHN L. YOUNG, ESQ.
PRIMARY EXAMINER

June 23, 2004